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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,285	05/30/2000	Nicholas S. Adams	6745	8319

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EXAMINER

ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,285

Applicant(s)

ADAMS ET AL.

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8,9,12,14,20 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8,9,12,14,20 and 25-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 14, 25-27, 29-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wohead 3,670,447.

Wohead discloses an elongated body (generally 13 of 12,10) with a line connection end (17, 29) and a free end (15,18) and having a buoyant section (20) and a weighted section (15), the weighted section made of a sinking material (15 is not buoyant; see col. 2, lines 16 & 17 wherein it states "...chamber 20 which is a buoyant portion of the device 10") and being positioned closer to the free end than the buoyant section (see Fig. 3), and a noise generating element non-detachably ("non-detachable" has been interpreted as not detachable during normal fishing use and also as not detachable in a purely axial direction, as when a strictly axial force is applied; the term "non-detachable" can be interpreted in this manner since the non-detachable structure is not being more particularly claimed) connected with the weighted section (15) at the free end (18, 15) by a non-detachable connection (threads do not allow parts to detach during normal use [user initiates disassembly, cannot fall apart during normal usage] or when longitudinal pulling forces are applied thereat) between the noise generating element and the weighted section so that the weighted section is between the buoyant

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section and the noise generating element, the noise generating element comprising a closed hollow member (14 is closed at 23 and also at the top via 25 and is also enclosed) and one or more noise generating objects (28).

In reference to claim 3, Wohead discloses the tubular member includes part (23) which is made of metal.

In reference to claim 27, Wohead discloses the hollow member being a closed member (22 closes off one end while 25 closes off the other end).

In reference to claim 26, Wohead discloses an elongated body (generally 13 of 12, 10) having a line connection end (17, 29) and a free end (15, 18), the body made of at least in part of a solid weighted material having a density greater than water (15 is not buoyant; also see col. 2, lines 27-33 wherein a wire may also be used to form part of a connection with 25 wherein wires are made of metals which have densities greater than water) and being sufficiently weighted to cause the sinker to sink in water (see Figs. 1, 2, and 4 wherein the device is shown as tending to orient itself below the surface of the water; all of the structure of the device lends to the total weight of the device so as to cause it to sink in water), a weighted section (15), and a noise generating element (14, 23, 28) connected with the elongated body at the free end so that the entirety of the weighted portion (15) is between the noise generating element and the line connection end and the noise generating element is not removable from the elongated body (the interconnection at 25 does not allow separation of parts during use; see Figs. 1 & 2 wherein snags such as rocks 36 do not cause the noise generating element to be removed from the body), the noise generating element comprising a hollow member

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(14) and a fixed number of noise generating objects (28; user places the desired number of weights and that becomes a fixed number).

In regard to claim 30, "unitary" is defined as "having the character of a unit: WHOLE".

In regard to claims 33 and 35, Wohead discloses the fixed number of noise generating elements is not adjustable (during use and when the device is submerged, the number of elements is not adjustable).

3. Claims 1, 14, 26, 27, 30-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Witkoski 3,736,690.

In reference to claim 1, Witkowski discloses a body (16) with a line connection end (30), a free end (adjacent 40), a weighted section made of sinking material (32 made of metal [cross-section in Fig. 1]), a buoyant section (18), a noise generating element non-detachably (the element of Witkowski is not detachable under normal use since the groove 40 snap fits with the bead 42 to prevent the parts from detaching unless effected by the user; also the body 50 is not detachable in the purely axial direction) connected with the weighted section (40, 42, 44) at the free end by a non-detachable connection (snap fit thereat is not detachable when used as shown in Fig. 3) between the noise generating element and the weighted section so that the weighted section is between the buoyant section (18) and the noise generating element which comprises a closed hollow tube (50 is closed at 55 and by 32) and a fixed number of noise generating objects (14; number of objects is fixed during use).

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In regard to claim 26, Witkowski discloses the weighted section (32) being sufficiently weighted to cause the fishing sinker to sink in water (made of metal; see Fig. 3 wherein the device is located at the bottom of a body of water) and the noise generating element is not removable from the body (snap fit does not allow the noise generating element to be removed from the body during normal usage).

In regard to claims 31 and 34, Witkowski discloses an eyelet (30).

In regard to claims 33 and 35, Witkowski discloses the fixed number of noise generating objects not adjustable (during use and when the device is submerged, the number of elements is not adjustable).

4. Claims 26, 27, 29, 34, 35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Keeton 5,144,765.

Keeton discloses a fishing sinker with an elongated body (non-floating body member 12) with a line connection end (forward end of the body), a free end (16), a weighted section (12 made of metals such as brass or stainless steel) being sufficiently weighted to cause the sinker to sink in water (see Figs. 5 & 6); and a noise generating element (20 in Fig. 2) non-detachably connected (via 24; see col. 4, lines 3-11 which states that "flaring...so that the collar or ring **cannot be lost**") by a non-detachable connection (flared end prevents detachment) so that the entirety of the weighted section is between the noise generating element and the line connection end (see Fig. 2), the noise generating member is not removable from the elongated body and comprising a hollow member (32) and a fixed number of noise generating objects (34 has a solid wall

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or has a seam 36 that is joined together using cement or the like after insertion of the objects 34; see Fig. 3a).

In reference to claim 29, Keeton discloses the hollow member constructed of a different material (plastic or fiberglass; also see col. 4, lines 58-68 & col. 6, lines 54-58) than the weighted material.

In regard to claim 34, Keeton discloses an eyelet (at end of 18).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 8, 14, 25-27, 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wohead 3,670,447.

Alternatively in reference to claims 1 and 26, Wohead does not disclose the noise generating element being non-detachably connected with the weighted section. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the noise generating element being non-detachably connected with the weighted section, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, and because by making the noise generating element non-detachable from the weighted section would prevent both alteration of the sinker when in the desired configuration and separation of the parts during fishing. *Howard v. Detroit Stove*

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Works, 150 U.S. 164 (1893). Also, it would have been obvious to a person of ordinary skill in the art to make the noise generating element being non-detachably connected with the weighted section in order to permanently set the device such that the number of noise generating members/weight elements is a known quantity by the fisherman so that the total weight of the sinker can be reliably expected by the user.

In reference to claims 8, Wohead discloses the claimed invention except for the noise generating element molded into the weighted portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mold the noise generating element into the weighted portion, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, and because molding the noise generating element with the weighted portion would assure that the noise generating element does not become easily separated therefrom and render the device useless. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

In reference to claims 25 and 29, Alternatively Wohead does not disclose the hollow member made of a different material than the weighted material. It would have been an obvious matter of design choice to construct the hollow member out of different material than the weighted material, since applicant has not disclosed that by doing so solves any stated problem or is for any particular purpose and it appears that the hollow member and weighted material would perform equally as well by being made of different materials and because by making some portions that do not undergo stress out of cheaper materials would save costs in the design.

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7. Claims 9, 20, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wohead 3,670,447 in view of Tharp et al. 4,649,662.

Wohead does not disclose an exterior coating covering the body and noise generating element. Tharp et al. discloses a fishing post which may be made of different colors including fluorescent colors such as fluorescent reds and that they may also be made phosphorescent with special coatings and that wooden posts may be painted (coating of paint). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the coating of Tharp et al. on the sinker of Wohead in order to make the sinker a certain color which will draw the attention of the fish to the sinker and therefore to the baited hook so as to catch more fish.

In reference to claim 9, Wohead and Tharp et al. do not particularly disclose a plastic seal coating. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a plastic seal coating, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because a plastic coating would be equally capable of providing the sinker with a certain color. *In re Leshin*, 125 USPQ 416.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wohead 3,670,447 in view of Lysikowski 2,589,715, Dickinson 4,428,144, Rossa 4,750,289, or Rhinehart 5,253,447.

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Wohead does not disclose a wire extending substantially through the entirety of the body wherein the wire has an end defining a line connection end. Lysikowski, Dickinson, Rossa, and Rhinehart all disclose a wire extending from a first end for line attachment and also through the body of the sinker and exiting and extending from the free end of the sinker for engagement with the bottom to prevent snagging in either the hook or the sinker. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the sinker of Wohead to include the wire member as taught by Lysikowski, Dickinson, Rossa, or Rhinehart to prevent the fishing rig from snagging on bottom obstructions.

9. Claims 1, 14, 25-27, 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witkowski 3,736,690.

Alternatively in reference to claims 1 and 26, Witkowski does not disclose the noise generating element being non-detachably connected with the weighted section. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the noise generating element being non-detachably connected with the weighted section, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art; and because by making the noise generating element non-detachable from the weighted section would prevent both alteration of the sinker when in the desired configuration and separation of the parts during fishing. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Also, it would have been obvious to a person of ordinary skill in the art to make the noise generating element being non-detachably connected

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with the weighted section in order to permanently set the device such that the number of noise generating members/weight elements is a known quantity by the fisherman so that the total weight of the sinker can be reliably expected by the user.

In reference to claims 25 and 29, Witkowski does not disclose the hollow member made of different material than the weighted material. It would have been an obvious matter of design choice to construct the hollow member out of different material than the weighted material, since applicant has not disclosed that by doing so solves any stated problem or is for any particular purpose and it appears that the hollow member and weighted material would perform equally as well by being made of different materials and because by making some portions that do not undergo stress out of cheaper materials would save costs in the design.

10. Claims 20, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witkoski 3,736,690 in view of Tharp et al. 4,649,662.

Witkowski does not disclose an exterior coating covering the body and noise generating element. Tharp et al. discloses a fishing post which may be made of different colors including fluorescent colors such as fluorescent reds and that they may also be made phosphorescent with special coatings and that wooden posts may be painted (coating of paint). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the coating of Tharp et al. on the sinker of Witkowski in order to make the device a certain color which will draw the attention of the fish to the device and therefore to the baited hook so as to catch more fish.

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11. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keeton 5,144,765.

Alternatively, Keeton does not disclose an eyelet at the free end (18) in the embodiment shown in Fig. 2, but it does have an eyelet (63 or to which 98 is attached) at a free end in Figs. 7 or 8. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the embodiment of Fig. 2 such that an eyelet is provided in order to provide a presentation wherein the lure does not slide along the line which may cause some abrasion to the line.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-4195 for regular communications and (703) 306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Darren W. Ark
Primary Examiner
Art Unit 3643

DWA
March 10, 2003